REMARKS

Applicants submit these Remarks in reply to the Final Office Action mailed June 11, 2008. Following this Amendment, claims 1-20 remain pending in this application, of which claims 1, 7, and 8 are independent.

In the Office Action, the Examiner took the following actions:

i. rejected claims 1-8, 11-13, and 16-18 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Publication No. 2002/0032777 ("*Kawata*");

ii. rejected claims 9, 14, and 19 under 35 U.S.C. § 103(a) as being unpatentable over *Kawata* in view of U.S. Patent No. 7,251,691 ("*Boyd*");

iii. rejected claims 10, 15, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Kawata* in view of U.S. Patent No. 6,598,071 ("*Hayashi*"); and

iv. withdrew objections to claims 7-8 under 35 U.S.C. § 101.

With this Amendment, Applicants have amended independent claim 1 to recite the following:

> 1. A method for use in a computer system comprising at least one first computer in an existing cluster of computers and one second computer, the system for processing consecutive inquiries of an external computer, the method comprising:
>
> observing the processing time that the first computer requires for processing a first inquiry of the external computer,
>
> performing an availability test to identify the second computer,

incorporating the second computer into the existing cluster, if, based on the availability test, no suitable computer is available in the existing cluster, and

rerouting a second inquiry from the first computer to the second computer if the processing time exceeds a standard time, the method being characterised in that the standard time is dependent on the type of inquiry.

Applicants have similarly amended independent claims 7 and 8. Applicants' Specification provides support for these amendments, for example, at paragraphs 0031 and 0041. Accordingly, the amendments introduce no new matter.

Applicants respectfully submit that the pending claims, as presently amended, are allowable over the art of record for at least the reasons discussed below.

A. Claim Rejections Under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 1-8, 11-13, and 16-18 under 35 U.S.C. § 102(b) as being anticipated by *Kawata*. To establish anticipation under § 102(b), the Examiner must show that *Kawata* discloses each and every element of the Applicants' claims, either expressly or inherently. *See In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Furthermore, the identical disclosure "must be shown in as complete detail as is contained in the ... claim." *See* M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that *Kawata* fails to disclose every feature of independent claim 1.

Applicants' independent claim 1 now recites, among other things, "performing an availability test to identify the second computer, [and] incorporating the second computer into the cluster, if, based on the availability test, no suitable computer is

available in the existing cluster . . . ." *Kawata* fails to teach or suggest at least these features for the following reasons.

Kawata discloses neither "performing an availability test" nor "incorporating the second computer into the cluster based on an availability test." Instead, *Kawata* discloses a system that "provides load balancing based on the real-time load status of servers." (*Kawata* at Abstract.) To that end, *Kawata* employs a "load balancer 100, which distributes the service requests from the clients 105 to the servers." (*Id.* at ¶ 0037 (referencing Fig. 1).) This described load balancer makes distribution decisions by a server selection module, which selects among the servers by comparing their respective "load evaluation values." (*See e.g., id.* at ¶¶ 0040, 0067.)

Thus, while *Kawata* distributes data among servers based on measured load evaluation values, it does not hint at incorporating an additional computer into an existing cluster of computers based on an availability test. For example, in its description of the server selection process, *Kawata* merely describes selecting a server from a given set of servers by looking up and comparing the servers' load evaluation values in a load management table. (*See, e.g.,* ¶¶ 0066-67; Fig. 10.) Thus, because *Kawata* merely routes service request among a given group of servers, it does not teach or suggest either "performing an availability test" or "incorporating the second computer into the cluster, if, based on the availability test, no suitable computer is available in the existing cluster," as recited by independent claim 1.

For at least this reason, *Kawata* does not disclose each and every recitation of independent claim 1. Further, claims 7 and 8, though they differ in scope from claim 1, contain recitations similar to those discussed above for claim 1 and are patentably distinguishable over the cited art for the same reasons. Finally, because dependent claims 2-6, 11-13, and 16-18 necessarily include the recitations of their respective independent claims, none of the cited art teaches or suggests every limitation of the dependent claims. Accordingly, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 102(b) against pending claims 1-8, 11-13, and 16-18 and reconsider such claims.

B. Claim Rejections Under 35 U.S.C. § 103(a)

Further, Applicants respectfully traverse the rejection of claims 9-10, 14-15, and 19-20 under 35 U.S.C. § 103(a). To establish a *prima facie* case of obviousness, the prior art reference must teach or suggest all the claim limitations. *See* M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established at least because none of *Kawata, Boyd,* nor *Hayashi*, nor their combination, teaches or suggests every feature of Applicants' claims. Applicants have already established in the previous section that *Kawata* fails to disclose at least "performing an availability test to identify

the second computer, [and] incorporating the second computer into the cluster, if, based on the availability test, no suitable computer is available in the existing cluster . . . ." Moreover, none of the remaining references cures this deficiency.

Hayashi, for example, merely discloses monitoring traffic between server and client and switching servers dynamically based on factors such as communication speed and response time. (*See* Abstract.) As such, it too does not appear to hint "performing an availability test" or "incorporating the second computer . . . based on the availability test."

Furthermore, *Boyd* also fails to teach or suggest the same features. Instead, *Boyd* merely discloses a method of optimizing the overall latency of transferring data from peer computers to a plurality storage devices. (Col. 2, ll. 19-22.)

For at least these reasons, Applicants respectfully request the Examiner withdraw the Section 103(a) rejection of claims 9, 14, and 19 over the combination of *Kawata* and *Boyd* and claims 10, 15, and 20 over the combination of *Kawata* and *Hayashi*.

C. Conclusion

The preceding remarks are based only on the assertions included in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other subject matter that is not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and timely allowance of the pending claims, 1-20.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 20, 2008

By: _____

Brannon McKay
Reg. No. 57,491
(404) 653-6410